

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

AMERICAN IMAGING SERVICES, INC.,	§	
	§	
Plaintiff,	§	
v.	§	Civil Action No. 3:09-CV-733-M
	§	
AUTODESK, INC.,	§	JURY TRIAL DEMANDED
	§	
Defendant.	§	

NOTICE OF DECISION ON FOURTH PETITION FOR REEXAMINATION

On April 2, 2013, Defendant Autodesk, Inc. filed its Fourth Petition for Reexamination relating to U.S. Patent No. RE40,384 (the Patent-in-Suit in this case). On May 3, 2013, the United States Patent and Trademark Office denied Autodesk's request for ex parte reexamination. A copy of the Examiner's decision is attached hereto as Exhibit A.

Dated: May 8, 2013.

Respectfully submitted,

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ATTORNEYS FOR PLAINTIFF

CERTIFICATE OF SERVICE

I hereby certify that on the 8th day of May, 2013, I electronically filed the foregoing document with the clerk of the court for the U.S. District Court, Northern District of Texas, Dallas Division, using the electronic case filing system of the court. The electronic case filing system sent a “Notice of Electronic Filing” to the attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means.

/s/ Dave R. Gunter

EXHIBIT A

(Attached)

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination
	90/012,826	RE40384 ET AL.
	Examiner	Art Unit
	JOSEPH R. POKRZYWA	3992

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 02 April 2013 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☐ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☒ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) ☐ by Treasury check or,
b) ☒ by credit to Deposit Account No. 02-2666, or
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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cc: Requester (if third party requester)

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DETAILED ACTION

Response to Request for *ex parte* Reexamination

1. Reexamination has been requested for claims 14, 15, 108, and 114 of United States Patent Number RE40,384 to Opincar *et al.* (hereafter “the ‘384 Patent”).
2. Under 35 U.S.C. 304, the Office must determine whether “a substantial new question of patentability” (“SNQ”) affecting any claim of the patent has been raised. If an SNQ is found, an order for reexamination of the patent is granted.
3. In this regard, MPEP 2217 states, in part:

Substantial new questions of patentability must be based on patents or printed publications. Other matters, such as public use or on sale, inventorship, 35 U.S.C. 101, 35 U.S.C. 112, * > conduct < , etc., will not be considered when making the determination on the request and should not be presented in the request. Further, a prior art patent or printed publication cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or on sale, **insufficiency of disclosure**, etc. The prior art patent or printed publication must be applied directly to claims under 35 U.S.C. 103 and/or an appropriate portion of 35 U.S.C. 102 or relate to the application of other prior art patents or printed publications to claims on such grounds. [Emphasis added].

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4. Additionally, MPEP 2242 states:

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, **unless the same question of patentability has already been decided by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent.** A “previous examination” of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the **examination of the patent in an earlier pending or concluded reexamination.** [Emphasis added].

5. In this regard, NO substantial new question of patentability affecting claims 14, 15, 108, and 114 of the ‘384 Patent is raised by the Third Party’s request for *ex parte* reexamination.

6. The ‘384 Patent was reissued on Jun. 17, 2008 with patented claims 1-114, whereby the ‘384 Patent is a reissue of original U.S. Patent 5,353,393, issued on Oct. 4, 1994, filed as U.S. Application 07/984,009 on Nov. 30, 1992. Further, the 07/984,009 Application is a continuation of application 07/782,876, filed on Oct. 17, 1991, which was abandoned, which is a continuation of application 07/366,665, filed on Jun. 14, 1989, which was abandoned.

7. The examiner notes that each claims 14, 15, 108, and 114 of the ‘384 Patent were subject in the earlier reexamination proceeding of Control No. 90/011,073, whereby that proceeding indicated that claims 14, 15, 108 and 114 were confirmed as patentable.

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8. Additionally, the '384 Patent has expired. In this regard, MPEP 2258 states, in part:

Original patent claims will be examined *only* on the basis of prior art patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103. See MPEP § 2217. During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). In a **reexamination proceeding involving claims of an expired patent**, claim construction pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (**words of a claim “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment.** The statutory presumption of validity, 35 U.S.C. 282, has no application in reexamination (*In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985)). [Emphasis added].

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Listing of Prior Art

9. In the current Request for Reexamination filed 4/2/2013, the Third Party Requester alleges that the '384 Patent's claims 14, 15, 108, and 114 is unpatentable in light of the following references:

- a. "AutoSketch User Guide", June 6, 1988 (noted as the "AutoSketch Manual");
- b. "Linking CAD to the Past!" one page brochure, which was distributed at Chicago Trade Show on May 2-5, 1988 (noted as "Linking CAD to the Past"); and
- c. "Canvas, Complete Graphics Environment for the Macintosh", Version 1.0, 1987 (noted as "Canvas Manual").

10. The aforementioned cited reference of the AutoSketch Manual is not of record in the file of the '384 Patent and is not cumulative to the art of record in the original file. However, the reference of the Canvas Manual was cited and utilized in a rejection within the previous reexamination proceeding 90/011,073. Further, the Linking CAD to the Past brochure was cited in the previous reissue proceeding, being listed in an Information Disclosure Statement, but the reference was not specifically discussed or utilized in any rejection.

11. Additionally, the Third Party Requester also submitted numerous Declarations and Court documents with the Request for Reexamination. But as noted above, MPEP 2217 is clear that a substantial new question of patentability must be based on patents or printed publications, whereby the submitted declarations and Court documents are clearly not prior art patents or printed publications.

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Requester's Position

12. The request indicates that the Third Party Requester alleges that:

SNQ#1. A substantial new question of patentability of claims 14-15, 108, and 114 of the '384 Patent is raised by the combination of the AutoSketch Manual in view of Linking CAD to the Past, and further in view of the Canvas Manual.

Discussion of Substantial New Question of Patentability

13. First, it is noted that in the instant Request for Reexamination dated 4/2/2013, claims 14, 15, 108, and 114 of the RE40,384 Patent are requested by the Third Party Requester, wherein claims 14 and 108 are independent. Further, it is noted that the claims of the current '384 Patent have expired. Because of this, the reexamination proceeding must be pursuant to 37 CFR 1.530(j), which states "No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent." Additionally, MPEP 2258 states, in part:

Original patent claims will be examined *only* on the basis of prior art patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103. See MPEP § 2217. During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). In a **reexamination proceeding involving claims of an expired patent**, claim construction pursuant to the principle set forth by the

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court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (**words of a claim “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment.** The statutory presumption of validity, 35 U.S.C. 282, has no application in reexamination (*In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985)). [Emphasis added].

14. Thus, because the ‘384 Patent is expired, the interpretation of the words in the claim language will be “generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art at the time of the invention. With this, independent claims 14 and 108 (as well as their corresponding requested dependent claims 15 and 114) each require methods of displaying a raster image and displaying a vector image in response to user input commands, whereby the raster image and the vector image are displayed in a window having coordinates referenced to a vector origin, and the raster image and the vector image are maintained in registration using the coordinates.

15. Continuing, looking into the prosecution history of the ‘384 Patent, during the reissue proceeding, independent claim 108 was added, which contained similar limitations as that of amended independent claim 14, whereby claim 14 was amended to include the limitation that required “said second image being displayed in a window having coordinates referenced to a vector origin, wherein said first image is maintained in registration with said second image using said coordinates”. Thus, in the reissue proceeding, this feature was deemed to by the patentable feature.

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16. Continuing, during the first reexamination proceeding, being 90/011,073, as noted above, claims 14, 15, 108, and 114 were each indicated as being confirmed as patentable over the cited prior art references, with the primary cited prior art reference being the Canvas Manual in that proceeding, being a reference also cited in the proposed combination in the instant Request. Particularly, in the previous reexamination proceeding, regarding independent claim 14, the Examiner at the time stated on page 3 of the NIRC dated 4/27/2012 that “In this case, Patent Owner’s appeal brief filed 12/27/2011 emphasizes the ordinary meaning of certain claim limitations in the context of the written description and the prosecution history. In particular, Patent owner asserts that the prior art of record does not disclose ‘coordinates referenced to a vector origin’, where a raster image is maintained in registration with a vector image using coordinates, as claimed in independent claims 14 and 108.” Further, the Examiner at the time additionally stated on pages 3 and 4 of the NIRC that “Accordingly, the claimed ‘vector origin’ is described in the context of a CAD system where the vector origin is a CAD origin. Primary reference, Canvas Manual, discloses a graphics system that allows a user to merge a raster image (pixel/bitmap graphics) with a draw object defined by its position on the screen. Page 75 of Canvas Manual illustrates a coordinate system, but fails to disclose or suggest a vector origin/CAD origin.”

17. Thus, with this, the feature that is deemed to be the reason that independent claim 14 was found patentable in the previous reexamination proceeding appears to be found in the limitation of “said second image being displayed in a window having coordinates referenced to a vector

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origin, wherein said first image is maintained in registration with said second image using said coordinates”. Similarly, the feature that is deemed to be the reason that independent claim 108 was found patentable appears to be found in the limitation that requires “wherein the vector-based image and the first raster image are displayed in a window having coordinates referenced to a vector origin; electronically maintaining said vector-based in registration with said raster image using said coordinates”. Once again, pursuant to MPEP 2258, because this reexamination proceeding is drawn to claims of an expired patent, the “words of a claim ‘are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention” is being applied since the expired claim are not subject to amendment.

18. With this, in the Request dated 4/9/2013, the Third Party Requester proposes that the combination of the AutoSketch Manual in view of the Linking CAD to the Past brochure, and further in view of the Canvas Manual raises a substantial new question of patentability as to independent claims 14 and 108. But in this regard, the Examiner disagrees, and does not believe that the combination of the AutoSketch Manual in view of the Linking CAD to the Past brochure, and further in view of the Canvas Manual actually discloses the patentable features that require “said second image being displayed in a window having coordinates referenced to a vector origin, wherein said first image is maintained in registration with said second image using said coordinates”, as required in independent claim 14, and similarly in independent claim 108.

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19. Particularly, the Third Party Requester describes that the AutoSketch Manual is a program that can create vector-based objects and store the models in a memory, and the AutoSketch Manual also discloses that the positioning of its vector-based objects uses X and Y coordinates to maintain the vector-based image in registration. The examiner agrees, in that the AutoSketch Manual is seen to teach these features. However, as noted above, the current language of claim 14, and similarly claim 108, requires that a raster image is maintained in registration with a vector image using a vector origin. With this, the AutoSketch Manual does not disclose any raster image whatsoever, as the reference of AutoSketch just discloses using vector-based images.

20. Continuing, in the Request, the Third Party Requester then discusses that the Linking CAD to the Past brochure teaches that raster images can be loaded into AutoCAD, whereby the reference describes that one can manipulate raster scanned drawings with AutoCAD, allowing pan, zoom, scale, and setting of a variable base point, and lets a user edit and embellish raster scanned drawings with vectors using ALL AutoCad tools. But with this, the Linking CAD to the Past brochure advertises the introduction of multiple different separate software programs from Luna imaging, in particular, the LunaLink software, the LunaEdit software, and the LunaLibrarian software. With this, the reference, in itself, is not clear if a raster image is maintained in registration with a vector image using a vector origin. The Linking CAD to the Past brochure simply gives a few features of the particular software, and does not actually describe specific details as to how the images are maintained.

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21. Continuing, in the Request, the Third Party Requester additionally cites the Canvas Manual, which the Requester states as disclosing the simultaneous display of a raster image and vector-based image. First, the Canvas Manual describes features of the graphics environment for Macintosh computers. With this, at the time of the invention, it is unclear if the AutoCAD program, more specifically if AutoSketch program, which is described in the AutoSketch Manual, was compatible with Macintosh computers. Particularly, looking at the AutoSketch Manual reference on page 2, the manual states “The computer must have separate communications ports for the pointer and the plotter/printer. Version 2.0 or higher of PC-DOS/MS-DOS is also required.” With this, it is unclear what motivation would exist at the time of the invention to combine the teachings of the Canvas Manual, being within the graphics environment for Macintosh computers, with the AutoSketch drawing tool described in the primary reference of AutoSketch, which required Version 2.0 or higher of PC-DOS/MS-DOS. Further, as noted above, in the previous reexamination proceeding, the Canvas Manual was extensively discussed, and the claims were found patentable because the Canvas Manual is not seen to disclose said second image being displayed in a window having coordinates referenced to a vector origin, wherein said first image is maintained in registration with said second image using said coordinates”, as required in independent claim 14, and similarly in independent claim 108. Thus the same question of patentability was discussed in the concluded reexamination proceeding with respect to the Canvas Manual alone.

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22. With this, none of the three cited references in the proposed combination by the Third Party in the Request for Reexamination dated 4/2/2013 are seen to expressly disclose that a vector image and a raster image are maintained in registration using coordinates referenced to a vector origin. In the Request, the Third Party Requester relies heavily on the Linking CAD to the Past brochure for the teaching of this feature. But as noted above, and discussed further below, the advertisement of the Luna software is not seen to expressly disclose that a vector image and a raster image are maintained in registration using coordinates referenced to a vector origin.

23. Looking at the discussion of the Linking CAD to the Past brochure in the Request for Reexamination dated 4/2/2013, on pages 20 and 21, the Third Party Requester states that the reference describes LunaLink, which is software that “Lets you Manipulate Raster-Scanned Drawings with AutoCad. - Performs total drawing conversion using all AutoCad tools. - Allows pan, zoom, scale and setting of variable base point. - Output either in original raster or new vector format”. Further, the Third Party Requester states that the Linking CAD to the Past brochure also describes LunaEdit, which is software that “Gives AutoCad Users a Complete Set of Editing Tools for Raster-Scanned Drawings. - Lets you edit or embellish raster-scanned drawings with vectors using ALL AutoCad tools. - Allows the merging and plotting of the edited image with the raster-scanned image”.

24. But with this teaching in the Linking CAD to the Past reference, looking at the AutoSketch program, while being software made by the makers of AutoCAD, the AutoSketch

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software is not the same as AutoCAD. The AutoSketch program appears to not have the same exact toolset that are available in AutoCad, as in the AutoSketch Manual on page 1 of the Manual, the reference states "Thank you for purchasing AutoSketch, the precision drawing tool from the makers of AutoCAD, the world's most popular Computer-Aided Drafting (CAD) system. Using AutoSketch, you can get your feet wet in CAD without drowning in a sea of commands and options." With this, it is unclear if the LunaLink software or the LunaEdit software or the LunaLibrarian software, being separate products, could be used with the AutoSketch software, as the Third Party Requester suggests. As further discussed in the Linking CAD to the Past brochure, the LunaSeries software will be "Available soon for VersaCAD & CADKEY users." However nowhere does the reference of Linking CAD to the Past state that the LunaLink software or the LunaEdit software, or the LunaLibrarian software are available for AutoSketch users.

25. Further, the reference of Linking CAD to the Past is additionally unclear if these separate software programs of the LunaEdit software and the LunaLink software can operate together, or if the suggested features are exclusive to the particular software. For instance, LunaLink allows for the manipulation of raster images with AutoCAD, allowing for pan, zoom or scale settings. But the Linking CAD to the Past reference is not clear if the LunaLink software can display or edit the raster images with vector based images that represent user generated alterations to the raster image, and which are displayed in response to user input commands. Additionally, the Linking CAD to the Past reference is also unclear if the LunaEdit software, which is described as having a function that can edit or embellish raster scanned drawings with vectors, can also allow

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for panning or zooming of the merged images. Thus, the reference of Linking CAD to the Past is falling short of expressly disclosing the claimed feature of displaying a vector image in a window simultaneously with a raster image, with the vector image having coordinates referenced to a vector origin, whereby the **raster image is maintained in registration with the vector image using the coordinates.**

26. Once again, MPEP 2217 states, in part:

Substantial new questions of patentability must be based on patents or printed publications. Other matters, such as public use or on sale, inventorship, 35 U.S.C. 101, 35 U.S.C. 112, * > conduct <, etc., will not be considered when making the determination on the request and should not be presented in the request. Further, a prior art patent or printed publication cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or on sale, **insufficiency of disclosure**, etc. The prior art patent or printed publication must be applied directly to claims under 35 U.S.C. 103 and/or an appropriate portion of 35 U.S.C. 102 or relate to the application of other prior art patents or printed publications to claims on such grounds. [Emphasis added].

27. Continuing, on pages 22 and 23 of the Request for Reexamination, the Third Party Requester additionally discusses portions of deposition transcripts from corresponding litigation. For instance, the Third Party Requester discusses the 1998 testimony of Paul Bennett and also a rebuttal report from Tipton Cole. But as noted above, MPEP 2217 is clear that “Substantial new questions of patentability **must be based on patents or printed publications.**” [Emphasis added]. With this, in this reexamination proceeding, any substantial new question of

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patentability must be based on prior art patents and printed publications, and not based on portions of deposition transcripts that are described in the Request. As noted above, the reference of Linking CAD to the Past simply falls short of expressly disclosing “said first image is maintained in registration with said second image using said coordinates [which are referenced to a vector origin]”.

28. Further, on page 23 of the Request for Reexamination, the Third Party Requester additionally states that “the report of Tipton Cole from the AutoDesk Litigation submitted by AISI is insightful in that it states: ‘LunaLink...as of March 15, 1988, ...did display a raster image in a CAD environment. ...’ Requester respectfully submits that displaying a raster image in a CAD environment necessarily means that the raster image is in the same coordinate system ...as the vector-based image of the CAD environment. This use of the same coordinate system for the raster image and the vector-based image means they will be ‘maintained in registration...using said coordinates.’” With this, the Third Party Requester appears to be stating that the function of maintaining a raster image in a vector-based coordinate CAD system is inherent in the teaching provided in the Linking CAD to the Past brochure. But as noted above, the Linking CAD to the Past brochure describes separate functions of Luna software systems, which includes LunaLink, LunaEdit, and LunaLibrarian software, whereby each software tool appears to contain different functions. With this, it is not clear how separate functions of separate software systems can be considered as being inherent functions the Linking CAD to the Past reference. Perhaps the LunaLink software, which has a function of outputting “either in original raster or new vector format” would create a new coordinate system (being the “new vector format”) for the vector

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images, using the origin of the raster image. The advertisement of the Linking CAD to the Past simply is not clear enough, and is insufficient in its disclosure of the LunaLink software and/or the LunaEdit software to determine if the reference teaches of maintaining a vector image and a raster image in registration using the coordinates that are referenced to a vector origin, as required in independent claims 14 and 108.

29. Additionally, the Third Party Requester also submitted the Declaration of Udo Pooch, which discusses the proposed combination by the Third Party Requester, and states that the Linking CAD to the Past reference describes that a raster image and a vector image are maintained in registration, and would be obvious to include in the AutoSketch Manual that describes a vector origin for a vector image. But with this, as noted above, none of the AutoSketch Manual, the Linking CAD to the Past brochure, or the Canvas Manual, expressly describe maintaining a vector image and a raster image in registration using the coordinates that are referenced **to a vector origin**. This is precisely the reason that claims 14, 15, 108 and 114 were confirmed as patentable in the previous reexamination proceeding, which, as discussed above, stated that specification of the '384 Patent describes "the claimed 'vector origin' ...in the context of a CAD system where the vector origin is a CAD origin." The examiner agrees that the reference of the AutoSketch Manual does describe a vector origin. But there is no clear teaching in any of the cited references, nor is it discussed as being obvious to one of ordinary skill in the art at the time of the invention, to have the AutoSketch Manual, the Linking CAD to the Past brochure, or the Canvas Manual that expressly disclose that the vector origin is used for a coordinate system to maintain a vector image and a raster image in registration.

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30. Further, as noted above, MPEP 2217 requires that “Substantial new questions of patentability must be based on patents or printed publications.” Also, MPEP 2258, additionally states, in part:

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but **any rejection must be based upon the prior art patents or printed publications** as explained by the affidavits or declarations or other written evidence. **The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.** [Emphasis added].

31. Thus, in the instant case, any substantial new question of patentability must be based on the disclosures of the printed publications of the AutoSketch Manual, the Linking CAD to the Past, and the Canvas Manual, and not found in the written evidence of the Pooch Declaration. With this, while the Pooch Declaration does state in paragraph 9 that “someone with experience using CAD systems at that time would understand this reliance on the CAD environment to mean that the coordinates referenced to the origin of the CAD environment are used during the pan and zoom operations to keep the ‘raster scanned drawings’ and ‘vector’ in sync.” But as discussed above, the Linking CAD to the Past advertisement does not expressly describe that pan and zoom operations use coordinates referenced to the vector origin in the CAD environment. While this may be the case, the examiner notes that it may be possible that the pan and zoom operations in the Linking CAD to the Past brochure may use coordinates referenced to a raster

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origin. The reference of Linking CAD to the Past is insufficient in actually disclosing if pan and zoom operations use coordinates referenced to the vector origin. Thus, neither the Linking CAD to the Past brochure, nor the AutoSketch Manual, are seen to expressly disclose the feature of having a raster image maintained in registration with a vector image using a vector origin, as currently required in independent claims 14 and 108.

32. Therefore, the combination of the AutoSketch Manual, the Linking CAD to the Past reference, and the Canvas Manual are not seen to teach the limitations of “said second image being displayed in a window having coordinates referenced to a vector origin, wherein said first image is maintained in registration with the second image using said coordinates”, as required in independent claim 14. Further, the combination of the AutoSketch Manual, the Linking CAD to the Past reference, and the Canvas Manual are not seen to teach the limitations of “wherein the vector-based image and the first raster image are displayed in a window having coordinates referenced to a vector origin; electronically maintaining said vector-based in a registration with said raster image using said coordinates”, as required in independent claim 108. Therefore, no substantial new question of patentability has been established based on the combination of the AutoSketch Manual, the Linking CAD to the Past reference, and the Canvas Manual, as proposed by the Third Party Requester.

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Conclusion

33. Therefore, since the request for *ex parte* reexamination does not raise a substantial new question of patentability, the request for *ex parte* reexamination of claims 14, 15, 108, and 114 of U.S. Patent Number RE40,384 is DENIED.

34. ALL correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

Please mail any communications to:

Attn: Mail Stop "*Ex Parte* Reexam"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

Please FAX any communications to:

(571) 273-9900
Central Reexamination Unit

Please hand-deliver any communications to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Joseph R. Pokrzywa/

Joseph R. Pokrzywa
Primary Examiner
Central Reexamination Unit 3992
(571) 272-7410

Conferees:

/ERON J SORRELL/
Primary Examiner, Art Unit 3992

/Daniel J Ryman/
Supervisory Patent Examiner, Art Unit 3992

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		
	Filing Date		
	First Named Inventor	William Opincar	
	Art Unit		
	Examiner Name		
	Attorney Docket Number	8873R004E	

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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
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Application Number	
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First Named Inventor	William Opincar
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Examiner Name	
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/J.P./	1	AutoSketch User Guide (June 6, 1988) ("AutoSketch Manual")	<input type="checkbox"/>
/J.P./	2	Linking CAD to the Past Brochure Distributed at Chicago Trade Show ("Linking CAD to the Past") on May 2-5, 1988	<input type="checkbox"/>
/J.P./	3	Canvas, Complete Graphics Environment for the Macintosh, Version 1.0 (1987) ("Canvas Manual")	<input type="checkbox"/>
/J.P./	4	37 CFR 1.131 Declarations submitted by AISI in the reissue application in which named inventors William A. Opincar and Paul Bennett state that "Linking CAD to the Past" was handed out at the May 2-5, 1988 Chicago A/E/C tradeshow where a version of software containing some of the features of the claimed invention was demonstrated.	<input type="checkbox"/>
/J.P./	5	Declaration of Jorge Miranda (the creator of Canvas)	<input type="checkbox"/>
/J.P./	6	Declaration of Dr. Udo Pooch ("Pooch Declaration")	<input type="checkbox"/>

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¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

Case 3:09-cv-00733-M Document 288 Filed 05/08/13 Page 26 of 28 PageID 14801	
Receipt date: 04/02/2013	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	
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CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

☐ That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

- ☐ See attached certification statement.
- ☐ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.
- ☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Daniel M. De Vos/	Date (YYYY-MM-DD)	2013-04-02
Name/Print	Daniel M. De Vos	Registration Number	37813

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PATENT NO. RE40384 ET AL.

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Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).